

REMARKS

The Official Action of May 27, 2009 finally rejected all the claims then pending in the application. Claims 1–18 were finally rejected under 35 U.S.C. 102(b) as being anticipated by Furusawa U.S. Patent 2001/0041901, particularly Fig. 19; and the remaining Claims 9–20 were finally rejected under 35 U.S.C. 103(a) as being unpatentable over Furusawa in view of several secondary references.

It is thus seen that Furusawa was the primary reference in the rejection of all the claims. However, from the Remarks applied by the Examiner in support of the relevancy of Furusawa, it appears that the structure, or the purpose of such structure, described in Furusawa, particularly Fig. 19 was not understood by the Examiner, as will be discussed more fully below. Therefore, in the hope that an Appeal can be avoided, applicant respectfully requests reconsideration of the Final Action in the light of the remarks set forth below concerning Furusawa.

In addition, to facilitate the further examination of the application, applicant has amended Claim 1 to include the subject matter of Claim 3, and has amended Claim 13 to include the subject matter of Claim 14. Such an amendment has the effect of merely cancelling Claims 1 and 3, and rewriting Claims 3 and 14 in independent form. Since the mere cancellation of claims clearly does not introduce any new issues, or require any further search, it is requested that these amendments be entered either as placing the application in condition for allowance, but if not so considered by the Examiner, then for purposes of appeal.

Since the Final Rejection of May 27, 2009 was based primarily on 35 U.S.C. 102, and secondarily on 35 U.S.C. 103, applicant feels that it will be helpful first to discuss the requirements of a rejection under each of the above sections of the Patents Law.

The propriety of a rejection under 35 U.S.C. 102 has been clearly established by many Court decisions; see for example, the following quotation from American Permahedge Inc. v. Barcana, Inc. 32 USPQ2d 1901 (at Pages 1807–1808):

“Prior art anticipates an invention, rendering it invalid, pursuant to 35 U.S.C. 102, if a single prior art reference contains each and every element of the patent at issue, operating in the same fashion to perform the identical function as the patented product. Scripps Clinic & Research Found v. Genentech, Inc., 927 F.2d 1565, 1576 [18 USPQ2d 1001] (Fed.Circ.1991); Carella v. Starlight Archery & Pro Line Co., 804 F.2d at

138. ‘There must be no difference between the claimed invention and the referenced disclosure, as viewed by a person of ordinary skill in the field of the invention.’ Scripps Clinic & Research Found v. Genentech, Inc., 927 F. 2d at 1576; see also E.I. Du Pont Nemours & Co. v. Polaroid Graphics Imaging, Inc., 706 F.Supp. 1135, 1142 [10 USPQ2d 1579] (D. Del 1989), aff’d, 887 F.2d 1095 [13 USPQ2d 1731] (Fed. Cir. 1989) (‘all of the same elements [must be] found in exactly the same situation and united in the same way ... in a single prior art reference’) (quoting Perkin Elmer Corp. v. Computervision, Corp., 732 F.2d 888, 894 [221 USPQ 669] (Fed. Cir. 1984). Thus, any degree of physical difference between the patented production and the prior art, no matter how slight, defeats the claim of anticipation. E.I. Du Pont de Nemours & Co. v. Polaroid Graphics Imaging, Inc., 706 F.Supp. At 1142”

The propriety of a rejection under 35 U.S.C. 103 has also been established by many Court decisions. See for example National Tractor Pullers Assn., Inc. v. Watkins 205 USPQ 892 wherein the Court stated (on Page 911):

“The test of obviousness under 35 U.S.C. 103 is not whether a prior art device could be modified into something resembling the applicant’s structure, but the proper test is whether, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art, given the teachings of the prior art, to make the invention. Graham v. John Deere, 383 US 1.148 USPQ 459 (1965). In considering the prior art, prior patents are references only for what they clearly disclose or suggest and it is not proper to modify their structure in a manner which is not suggested by prior art. In re Randol and Redford, 425 F.2d 1286, 165 USPQ 586 (CCPA 1970)”. A modification of a prior art patent or device which would render that device unworkable for its intended purpose cannot be said to suggest such a modification. Diamond International Corp. v. Walterhoefer, 289 F.Supp. 550, 159 USPQ 452 (DC. Md. 1968); Ex parte Weber, 154 USPQ 491 (P.O.Bd.Ap. 1967). (Underlining added.)

As will be shown below, neither of the above rejections, both based on Furusawa, is proper under the above Decisions.

As brought out in the response of January 26, 2009 to the previous rejection of November 3, 2008, the introductory portion of the specification in the present application discussed many drawbacks in the known implements of this type for manipulating a knotted suture to properly locate the knot with respect to the tissue being sutured, and then for removing excess suture from the knot. These drawbacks are avoided by the present invention, wherein the distal end of the implement shaft is formed with an open slot, namely a slot extending along the outer surface of the shaft, starting at a location

spaced from the end face and leading to the recess in the end face, such as enable the knotted suture to be introduced into the slot and the recess by effecting a sidewise movement of the knotted suture with respect to the shaft, or vice-versa. This broad concept was covered by the previous independent Claims 1 and 13.

The previous dependent Claims 3 and 14 added the further feature that the open slot is formed with a first section leading from the recess toward the proximal end of the elongated shaft, and a second section leading from a juncture with the first section towards the distal end of the elongated shaft but terminating short of the end face. All the foregoing features are clearly shown in Figs. 5-7 of the drawings.

In applying Furusawa to Claims 1-8 under 35 U.S.C. 102(b), the Examiner referred to Fig. 19c of that reference, and included a photocopy of that figure with legends showing how that reference was considered to show the structure defined in these claims. It is believed, however, that the Examiner completely misunderstood this reference, particularly Fig. 19c. We therefore enclose a photocopy of Fig. 19c of this reference on which we have added the additional reference numeral (6), consistent with all the preceding figures of the drawings, e.g., Figs. 11a, 12a, 13a, 14a. Elements "4" shown in Fig. 19c (also Fig. 19a) are the side folds, whereas element 5 is the gap portion between the side folds. Elements "6" on the opposite sides of recess 3 are "arcuate projections" which extend through the gap portion 5 to the outer surface of the litigation member (e.g. column 11, lines 45-59). The purpose of such arcuate projections 6 is "to lead the ligature 50 into the gap portion 5" (e.g. column 12, lines 50-55).

Clearly, therefore, this reference does not include the feature defined in the last clause of original Claim 1, namely:

"characterized in that said distal end of the elongated shaft is formed with an open slot starting from a location spaced from said end face and extending along the outer surface of the elongated shaft to said recess in said end face, such as to enable the knotted suture to be introduced into the slot and the recess by effecting a sidewise movement of the knotted suture with respect to the elongated shaft, or vice-versa."

As noted above, Claim 1 has been further amended to include the feature of Claim 3, setting forth that the open slot is formed with a first section leading from the recess toward the proximal end of the elongated shaft, and a second section leading from a juncture with the first section toward the distal end of the elongated shaft but

terminating short of the end face. These recitations refer to first section 133a of slot 133 and second section 133b of slot 133. These features are also clearly absent from Fig. 19c of Furusawa, as shown by the attached marked photocopy of Fig. 19c.

Thus, in applying this reference, it is not seen what the Examiner considers to be the “first section” and “second section” of the slot. On the one hand, if the Examiner considers the lower part of the slot in this reference to correspond to applicant’s “first section”, it is to be noted that while this slot leads to the recess 3, it does not extend along the outer surface of the elongated shaft to the recess. On the other hand, if the upper part of the slot 4 is considered by the Examiner as corresponding to the “second section”, it is to be noted that it does not lead from the juncture with the first section “toward said distal of the elongated shaft”, but rather extends in the radial direction.

From the foregoing, it is clear that the structure described in Furusawa, particularly in Fig. 19c, is clearly different from the structure defined particularly in amended Claim 1, and serves a completely different purpose than the structure in amended Claim 1.

The second independent claim, namely Claim 13, includes a similar structure as discussed above with respect to Claim 1, and therefore also clearly distinguishes over Claim 1 both under 35 U.S.C. 102 and 35 U.S.C. 103.

None of the secondary references cited by the Examiner against some of the dependent claims includes the structure, and the purpose of such structure, defined in amended Claims 1 and 13 as discussed above; therefore, it is submitted that these dependent claims are allowable over all the cited references for the same reasons as discussed above, in addition to the further features added in the respective dependent claims.

For the foregoing reasons, it is respectfully requested that the above amendments to the application be entered as placing the application in condition for allowance.

If, however, the Examiner feels otherwise, it is requested that these amendments be entered for purposes of appeal, since they introduce no new issues, or require any further search, but merely simplify the issues to be considered by the Board of Appeals.

Since the application is under Final, an early action is particularly solicited.

Respectfully submitted,



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Enclosure:

☐ Attachment: Fig. 19c of US2001/0041901